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#31

In re Application of Uwe Schoenrock et al. :
Serial No.: 09/132,799 :
Filed: August 13, 1998 : PETITION DECISION
Attorney Docket No.: BEIERSDORF-5 :
:

This is in response to applicants' renewed petition, filed May 6, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on August 13, 1998. The application, as filed, contained claims 1-10. On May 26, 1999, the examiner mailed an Office action including a restriction requirement dividing the claims into 2 groups, and requiring a further election of a single species of peptide for examination. In a telephonic interview, applicants had elected Group I, claims 1-6, and the monomer oligopeptide Ac-VVRP-NH₂ as the species to be examined. The examiner withdrew claim 5 from consideration as drawn to a non-elected species, namely longer chain acyl derivatives of VVRP and another oligopeptide. In the response filed December 1, 1999, applicants argued that all acyl derivatives of VVRP should be examined. On February 24, 2000 the examiner mailed a final Office action, wherein it was explained that other species would be examined if the elected species was found to be patentable. Prosecution has continued since that time, with the examiner mailing 5 subsequent Office actions. In an amendment filed July 29, 2002 applicant submitted new claims. In an Office action mailed October 8, 2002 the examiner withdrew from consideration claim 21, drawn to longer chain acyl derivatives of VVRP, as drawn to non-elected species. Applicants filed a petition under 37 CFR 1.144, requesting withdrawal of the restriction requirement, on January 13, 2003. This petition was denied in a decision mailed March 19, 2003.

DISCUSSION

Applicants argue that it was improper for the examiner to not provide any reason for holding the various claimed species to be patentably distinct, citing MPEP 816. This argument is not persuasive because MPEP 816 discusses the proper form of a restriction letter. The examiner did set forth the reasons for holding the two inventions ("groups") patentably distinct. Once an invention was elected, a further election of species was required. MPEP 809.02(a) sets forth the proper form of a requirement for election of species. The examiner clearly followed the correct

procedure for requiring election of species.

Applicants argue again that it would not be a burden to search for additional species. To reiterate USPTO procedure, additional species *will* be examined *if* the elected species is found to be patentable. At present, the elected species is not considered patentable.


Applicants argue that their election was directed to "a plurality of disclosed patentably distinct species." This is incorrect. The examiner stated that *the claims* are drawn to a plurality of patentably distinct species and required election of "*a single disclosed species*." Applicants elected the species of example 4, which is Ac-VVRP-NH₂. This is the species which has been examined throughout prosecution of the application.

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll 
Director, Technology Center 1600